

REMARKS

Claims 1-4, 7-8, and 23-34 are pending in this Application. In the Office Action Summary sheet, the Examiner indicates that claims 1-4, 8, and 23-34 are pending. The Applicants' respectfully point out to the Examiner that claim 7 is also pending in the present Application.

Claims 1-4, 8, and 23-34 were rejected by the Examiner. For purposes of convenience, the Applicants will proceed in the present reply as if claim 7 had also been rejected. The Applicants have amended claims 1, 2 and 28. All claim amendments are fully supported by the specification. No new matter has been added.

35 U.S.C. §102(e) – Claims 1-4, 8, and 23-34

The Examiner rejected claims 1-4, 8, and 23-34 under 35 U.S.C. §102(e) as being anticipated by Shaheen et al. (US Pub. No. 2005/0048969).

In making the rejection, the Examiner stated:

Regarding claims 1-4, 8, and 23-34, Shaheen discloses in a data communication system including a wireless subsystem for the transmission of data packets between a server and a wireless handset having a voice/data capability selectable between first and second operating modes, a method of selecting the operating mode of the handset after wireless communication is established between the handset and the subsystem, which comprises the steps of:

associating, with the system, a data base containing data indicative of the operating mode capability of the subsystem; transmitting query messages on the system from the handset to the data base to retrieve such capability data; and transmitting query messages on the wireless subsystem from the handset to the data base to retrieve the capability data; and operating the handset in the second mode if the retrieved capability data indicates that the subsystem is capable of operation in the second mode (pages 1-2 [0003] & [0020-0026] pages 3-4 [0039] and pages 4-5 [0047-0056] and see Fig. 2).

In fact, what the Shaheen reference discloses is a system wherein a subscriber unit is queried **by the system** as to the capabilities of the subscriber unit, when the subscriber unit moves from position to position.

Contrary to the Examiner's assertion, the Shaheen reference does not disclose, teach, or suggest anywhere that the handset transmits a query message to the database in order to determine the capability of the wireless subsystem. Additionally, there is no disclosure, teaching, or suggestion in the Shaheen reference that the data base transmits information to the handset regarding the capabilities of the wireless subsystem, including whether or not the wireless

subsystem is capable of operating in the second mode. Furthermore, there is no disclosure, teaching, or suggestion in the Shaheen reference of a data base transmitting operating capabilities in the first operating mode to the handset.

On the other hand, the Applicant's claimed invention in amended independent claim 1 recites, among other things: "transmitting query messages in the first operating mode on the wireless subsystem from the handset to the data base to retrieve the capability data" and "transmitting the capability data from the data base to the handset in the first operating mode" which is not disclosed, taught, or suggested anywhere in the Shaheen reference.

Similarly, the Applicant's claimed invention in amended independent claim 1 recites, among other things: "transmitting query messages in the first operating mode on the second wireless subsystem from the handset to the data base after execution of the handoff to retrieve the capability data" and "transmitting the capability data from the data base to the handset on the second wireless subsystem in the first operating mode" which is not disclosed, taught, or suggested anywhere in the Shaheen reference.

Likewise, the Applicant's claimed invention in amended independent claim 28 recites, among other things: "transmitting a query message from the mobile device to the capabilities server over the wireless subsystem in the first mode, wherein the query message requests the stored operating mode capabilities information of the wireless subsystem" and "transmitting the operating mode capabilities information from the capabilities server to the mobile device in the first

mode" which is not disclosed, taught, or suggested anywhere in the Shaheen reference.

Accordingly, the Applicants amended independent claims 1, 2, and 28 are patentably distinct from the Shaheen reference.

Claims 23-24 depend from patentable amended independent claim 1 and are therefore patentable for at least the same reasons as patentable amended independent claim 1.

Claims 3-4, 7-8, and 25-27 depend, either directly or indirectly, from patentable amended independent claim 2 and are therefore patentable for at least the same reasons as patentable amended independent claim 2.

Claims 29-34 depend from patentable amended independent claim 28 and are therefore patentable for at least the same reasons as patentable amended independent claim 28.


Conclusion

If the Examiner believes that any additional minor formal matters need to be addressed in order to place this application in condition for allowance, or that a telephone interview will help to materially advance the prosecution of this application, the Examiner is invited to contact the Applicant's undersigned attorney by telephone at the Examiner's convenience.

In view of the foregoing remarks and amendments, the Applicant respectfully submits that the present application, including claims 1-4, 7-8 and 23-34, is in condition for allowance and a notice to that effect is respectfully solicited.

Respectfully submitted,

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